

REMARKS

The Examiner's Action mailed on January 12, 2009, has been received and its contents carefully considered. Additionally attached to this Amendment is a Petition for a Two-month Extension of Time, extending the period for response to June 12, 2009.

Independent claims 37 and 49 are amended to incorporate the contents in claim 42 and claim 54, respectively. Claims 42 and 54 are cancelled. Claims 37, 44-46, 49, 55 and 60 are amended. Claims 37 and 49 are the independent claims, and claims 37-41, 43-53 and 55-63 remain pending in the application.

Favorable reconsideration of this application, in light of the following remarks, is respectfully requested.

Claim Rejections - 35 U.S.C. § 112

The Examiner has rejected claim 60 under 35 USC, Section 112, first paragraph, as failing to comply with the written description requirement. It is difficult to ascertain how the Examiner can make this rejection, as the subject matter recited in claim 60 is clearly supported by the original disclosure, on page 6, lines 1-3 and 20. Nevertheless, grammatical informalities were noted in the specification, and these have now been corrected, so as to recite the exact same

language as recited in claim 60. Further, claim 60 has been amended. It is thus requested that this rejection be withdrawn.

The Examiner has rejected Claims 37-63 under 35 USC, Section 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, various ones of the claims are amended in a manner that is consistent with the original disclosure. It is thus requested that this rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 102 & § 103

Applicants respectfully traverse these rejections for the reasons discussed below.

Applicants submit that Satoh et al. does not disclose the inorganic substrate has at least one passive components embedded therein, as admitted by Examiner in the page 6 of the office action. Applicants also submit that the through hole 20 in Satoh et al. is not a passive component.

Further, Satoh et al. teach a semiconductor connection substrate which connects a semiconductor element to a mounting substrate such as a printed substrate. It is clear that the substrate in Satoh et al. does not have a printed substrate.

Nishide et al. do not teach the combination of an organic substrate and an inorganic substrate as recited in independent claims 37 and 49.

Further, in order to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), all of the claim limitations of the rejected claims must be described or suggested by the cited document(s). (See *In Re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP § 2143.03) Applicants respectfully submit that the cited documents do not meet this criterion, because no combination of Satoh et al. and Nishide et al. will describe or suggest all of the claim limitations of independent claims 37 and 49, and therefore, a prima facie case of obviousness has not been established. Applicants respectfully submit that none of the references disclose or suggest the above or below features.

In particular, in the outstanding Office Action, the Examiner admits that none of Satoh et al. and Nishide et al. disclose or suggest that the organic substrate is composed of a plurality of stacked printed circuit boards. Should the Examiner be relying on his personal knowledge in support of this rejection, it is requested that the Examiner provide an affidavit to support his rejection.

Since the rejection fails to disclose or suggest each and every element of the rejected claims, Applicants respectfully submit that no prima facie case of obviousness has been established with respect to independent claims 37 and 49.

Further, in order to establish a *prima facie* case of obviousness, the Examiner must establish that it would have been obvious for one of ordinary skill

to have combined the teachings of the cited documents (See *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. at 398, 82 USPQ2d at 1396 (2007)). One way to establish this would be to show “some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness” and “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” Furthermore, the Examiner must make “*explicit*” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.”

It is respectfully submitted that the Examiner has not met these criteria. For example, the Examiner asserts that:

[i]t would have been obvious to one of an ordinary skill in the art at the time the invention was made to use an organic substrate is composed of a plurality stacked printed circuit board.....(See Office Action, page 8, 1st paragraph.)

However, it is respectfully submitted that the above statement is merely conclusory and do not comprise an “*explicit rationale*” as required by *KSR Int'l*. Therefore, because the Examiner has not provided an explicit analysis as required by *KSR Int'l*, a *prima facie* case of obviousness has not been established.

Moreover, in order to set forth a *prima facie* case of obviousness, the Examiner must demonstrate that there is some suggestion or motivation to modify the cited prior art references and/or combine the reference teachings. However, the Examiner has not met this requirement.

Applicants respectfully submit that the Examiner has merely provided a specious motivation to combine Satoh et al. and Nishide et al. The Examiner must demonstrate that there would be a motivation to combine Satoh et al. and Nishide et al. However, the Examiner has merely identified language in the Satoh et al. and Nishide et al. that is, at most, a purported advantage of using these references *alone*.

The Examiner's specious motivation to combine would, if permitted, effectively allow a purported advantage of a reference to be used as a basis for combining that reference with any other teaching in the prior art. Thus, the Examiner's argument is tantamount to saying that a reference may be combined with any other teaching in the prior art, so long as the reference purports to offer any general advantage. This is clearly improper, as it is safe to say that virtually every scientific or patent publication would lay claim to some advance over what was previously known. Taken to its logical conclusion, the Examiner's argument would allow the Satoh et al. and Nishide et al. references to be combined with any and all other teachings of the prior art. Such logic would effectively nullify the requirement that the Examiner demonstrate a motivation to combine references.

In view of the above, Applicants respectfully submit that none of the references teach or suggest each and every element of independent claims 37 and 49, and therefore, independent claims 37 and 49 are allowable over the cited prior art. Dependent claims are dependent from independent claims 37 and 49, and therefore, also allowable. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 102 and § 103 be reconsidered and withdrawn.

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these remarks are not intended to, nor need they, comprehensively address each and every reason for the patentability of the claimed subject matter over the applied prior art. Accordingly, Applicants do not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number below.

AMENDMENT

10/619,591

Should the remittance be accidentally missing or insufficient, or should any additional fees be required, the Director is hereby authorized to charge the fee to our Deposit Account No. 18-0002, and is requested to advise us accordingly.

Respectfully submitted,

June 12, 2009

Date



Robert H. Berdo, Jr. – Reg. No. 38,075
RABIN & BERDO, PC – Cust. No. 23995
Telephone: 202-371-8976
Fax: 202-408-0924

RHB/vm

AMENDMENT

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